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EXAMINER

DESANTO, MATTHEW F

ART UNIT

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

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8 *Ex parte* PAUL M. SCOPTON
9

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11 Appeal 2009-009559
12 Application 09/498,104
13 Technology Center 3700
14

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16 Decided: January 29, 2010
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19
20 *Before:* WILLIAM F. PATE, III, MURRIEL E. CRAWFORD, and
21 JENNIFER D. BAHR, *Administrative Patent Judges.*

22
23 CRAWFORD, *Administrative Patent Judge.*
24

25
26 DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 (2002) from a final rejection of claims 1 to 5 and 7 to 9. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellant invented a fluid injectable single operator exchange catheter and method of use (Spec. 1).

Claim 1 under appeal reads as follows:

1. A single operator exchange biliary catheter for use in combination with a guidewire and an endoscope, comprising:
 - an elongate shaft having a proximal end, a distal end and an injection lumen extending therethrough;
 - a guidewire lumen extending through a distal portion of the shaft between a proximal guidewire port and a distal guidewire port, the guidewire lumen being in fluid communication with the injection lumen of the shaft, the proximal guidewire port disposed proximal of the distal end of the shaft within the distal portion of the shaft, the distal guidewire port disposed at the distal end of the shaft;
 - a tubular member connected to the shaft, the tubular member extending proximally from the proximal guidewire port to a proximal end disposed distal of the proximal end of the shaft, the tubular member defining a guidewire lumen extension in fluid communication with the guidewire lumen and adapted to permit the guidewire to be retracted from guidewire lumen and re-inserted therein, the guidewire lumen extension being external to but parallel with the shaft; and
- wherein the guidewire lumen extension is axially aligned with the guidewire lumen.

1 The prior art relied upon by the Examiner in rejecting the claims on
2 appeal is:

3 Horzewski	US 4,771,777	Sep. 20, 1988
4 Crittenden	US 4,988,356	Jan. 29, 1991
5 Sirhan	US 5,984,945	Nov. 16, 1999

6 The Examiner rejected claims 1 to 5 under 35 U.S.C. § 102(e)
7 as being anticipated by Sirhan.

8 The Examiner rejected claims 1 to 5 and 7 under 35 U.S.C. § 102(b)
9 as being anticipated by Crittenden.

10 The Examiner rejected claims 1 to 5 and 7 to 9 under 35 U.S.C. §
11 102(b) as being anticipated by Horzewski.

12
13 ISSUES

14 Has Appellant shown that the Examiner erred in finding that Sirhan
15 discloses a guidewire lumen extension that is external to but parallel with the
16 shaft?

17 Has Appellant shown that the Examiner erred in finding that
18 Crittenden discloses guidewire ports?

19 Has Appellant shown that the Examiner erred in finding that
20 Horzewski discloses a tubular member connected to the shaft?

21
22 FINDINGS OF FACT

23 Sirhan discloses a guidewire replacement method that includes the
24 use of an elongate shaft 26, a guidewire lumen 30, and a tubular member 11
25 (Figs. 5, 6 and 15). The tubular member 11 has a part that is external to the

1 shaft 26. This part of tubular member 11 diverges away from the shaft 26
2 and therefore is not parallel to the shaft 26.

3 Crittenden discloses a catheter and guidewire exchange system
4 including a shaft 10 having a place or port where the guidewire 14 enters the
5 shaft where the slit 28 of shaft 10 engages guide member 12. This is a
6 proximal guidewire port (Fig. 9). Crittenden's catheter 10 also includes a
7 distal guidewire port 18 located where the guidewire exits the catheter (Fig.
8 1).

9 Horzewski discloses a perfusion type balloon dilatation catheter
10 including a shaft 31 and a guidewire port 47 (Fig. 4). A tubular member 71
11 surrounds shaft 31. Tubular member 71 is not connected to shaft 31 (Figs. 1
12 and 4).

14 PRINCIPLES OF LAW

15 A claim is anticipated only if each and every element as set forth in
16 the claim is found, either expressly or inherently described, in a single prior
17 art reference. *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631
18 (Fed. Cir.), *cert. denied*, 484 U.S. 827 (1987).

20 ANALYSIS

21 Anticipation by Sirhan

22 We agree with the Appellant that Sirhan does not disclose a guidewire
23 lumen extension that is external to but parallel with the shaft. The tubular
24 member 11 which defines the guidewire lumen extension diverges away

1 from the shaft 26 as clearly seen in Figures 1, 5, 6, and 15 of Sirhan. As
2 such, we will not sustain the Examiner's rejection of claim 1 and claims 2 to
3 4 dependent on claim 1 as anticipated by Sirhan.

4
5 Anticipation by Crittenden

6 We do not agree with the Appellant that the Examiner erred in finding
7 that Crittenden discloses a proximal guidewire port. In this regard we have
8 found that Crittenden discloses a proximal guidewire port, where the
9 guidewire enters the shaft 10. Contrary to the assertion of the Appellant, the
10 proximal guidewire port formed where the slit 28 of tubular member 10
11 engages the guide member 12 is a discrete opening. Therefore, we will
12 sustain the Examiner's rejection of claim 1 as anticipated by Crittenden. We
13 will also sustain this rejection as it is directed to claims 2 to 5 and 7 because
14 Appellant does not present any separate arguments for these claims. 37
15 C.F.R. § 41.37(c)(1)(vii) (2007).

16
17 Anticipation by Horzewski

18 We agree with Appellant that Horzewski does not disclose that tubular
19 member 71 is disposed as claimed i.e. connected to the shaft 31. Rather,
20 tubular member 31 surrounds the shaft but is not connected thereto.
21 Therefore we will not sustain this rejection of claim 1 and claims 2 to 5 and
22 claims 7 to 9 dependent thereon.

1 CONCLUSION OF LAW

2 On the record before us, Appellant has shown that the Examiner erred
3 in rejecting claims 1 to 5 under 35 U.S.C. § 102(e) as anticipated by Sirhan
4 and in rejecting claims 1 to 5 and 7 to 9 under 35 U.S.C. § 102(b) as
5 anticipated by Horzewski but has not shown that the Examiner erred in
6 rejecting claims 1 to 5 and 7 under 35 U.S.C. § 102(b) as anticipated by
7 Crittenden.

8
9 DECISION

10 The Examiner's rejection of claims 1 to 5 under 35 U.S.C. § 102(e) as
11 anticipated by Sirhan and of claims 1 to 5 and 7 to 9 under 35 U.S.C. §
12 102(b) as anticipated by Horzewski are not sustained. The Examiner's
13 rejection of claims 1 to 5 and 7 under 35 U.S.C. § 102(b) as anticipated by
14 Crittenden is sustained.

15 No time period for taking any subsequent action in connection with
16 this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
17 § 1.136(a)(1)(iv) (2007).

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19 AFFIRMED-IN- PART
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